

Gravois, Robert

From: Vignone, Maria <Maria.Vignone@USPTO.GOV> on behalf of Trials <Trials@USPTO.GOV>
Sent: Friday, October 24, 2014 10:08 AM
To: Crain, Andrew; Trials
Cc: areister@cov.com; gdischer@cov.com; Gravois, Robert; Knox, Kenny
Subject: RE: Conference Call Request IPR 2014-00717 & IPR 2014-00735

Counsel:

The panel provides the following guidance. *“The panel does not believe a conference is necessary at this time. The order of October 2, 2014 in IPR2014-00717 and IPR2014-00735 granted in part Patent Owner’s motion for additional discovery by ordering Petitioner to answer interrogatories and produce documents as specified in the order. The order does not require that Petitioner make Mr. Cho available for cross-examination.”*

Thank you,

Maria Vignone
Paralegal Operations Manager
Patent Trial and Appeal Board
571-272-4645

From: Crain, Andrew [<mailto:Andrew.Crain@thomashorstemeyer.com>]
Sent: Tuesday, October 21, 2014 5:52 PM
To: Trials
Cc: areister@cov.com; gdischer@cov.com; Gravois, Robert; Knox, Kenny
Subject: Conference Call Request IPR 2014-00717 & IPR 2014-00735

Dear PTAB Staff:

I am counsel for Patent Owner Black Hills Media in Case Nos. IPR2014-00717 and IPR2014-00735. These proceedings are assigned to Judges McNamara, McKone, Chen, and Ippolito. Petitioner’s counsel is copied on this email. Patent Owner also certifies that the parties have met and conferred on this issue and that the general substance of this email was previously vetted with Petitioner.

Patent Owner requests a conference with the Board relating to a request to cross-examine Declarant Sungil Cho with respect to his declaration previously submitted in these proceedings. Specifically, in Petitioner’s Opposition to Motion for Additional Discovery (Paper 16 in each IPR), Petitioner submitted a declaration from Mr. Sungil Cho (Ex. 1009 in each IPR). In the Order Granting-in-Part Patent Owner’s Motion for Additional Discovery (the Order), the Order indicates that Patent Owner is “entitled ... to cross-examine Mr. Cho.” Paper No. 17 in each IPR at p. 4.

The parties appear to have a disagreement about whether Patent Owner can depose Mr. Cho in regard to his declaration in view of Paper 17. In response to Patent Owner’s request, Petitioner indicated that it is not required to make Mr. Cho available for cross-examination. Patent Owner understands Petitioner to contend that it is not required to make Mr. Cho available for deposition because it was not explicitly ordered by the Board in Paper 17 and, thus, would be additional discovery that Patent Owner would have to request and obtain.

Therefore, the parties respectfully request a conference with the Board to seek guidance on this issue. The above description is not intended to be presented as a motion, brief, or argument, but is merely intended to constitute a general outline of the disagreement for the benefit of the Board.

For scheduling purposes, the parties are available on Thursday, October 23 from 1:30PM-2:30PM EDT; Friday, October 24 from 10:00AM-5:00PM; and Tuesday, October 28 10:00AM-3:00PM EDT.

Andrew Crain

Partner



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